

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of:	)	
	)	
Gilles RUBINSTENN et al.	)	Group Art Unit: 3628
	)	
Application No.: 10/024,351	)	Examiner: Igor N. Borissov
	)	
Filed: December 21, 2001	)	
	)	
For: CUSTOMIZED BEAUTY	)	Confirmation No.: 4841
TRACKING KIT	)	

**Attention: Mail Stop Appeal Brief-Patents**  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

**REPLY BRIEF UNDER 37 C.F.R. § 41.41**

Pursuant to 37 C.F.R. § 41.41, Appellant presents this Reply Brief responsive to the Examiner's Answer mailed on March 17, 2009. Appellant respectfully submits the following remarks.

I. **REMARKS**

In the Examiner's Answer dated March 17, 2009, the Examiner set forth new arguments not previously on record. Appellant respectfully submits the following remarks in response to the Examiner's new arguments.

a. **The Rejection of Claims 1-19 and 24 Under 35 U.S.C. § 101 Should Be Reversed Because the Methods Claimed Therein Operate on or Otherwise Involve Another Statutory Class of Invention.**

The Examiner asserts that independent claims 1 and 24 are not directed to patent eligible subject matter under 35 U.S.C. § 101 because claims 1 and 24 do not "require a machine for performing claimed method steps." Answer at 10 and 11. Appellant respectfully disagrees.

The Examiner apparently attempts to support his allegation that claims 1 and 24 do not "require a machine for performing claimed method steps" by asserting that "the method steps of 'selecting a set of personal questions from the personal questions stored on the computer-readable storage medium' does not require a computer for the 'selecting' step." Answer at 10. Further, the Examiner asserts that "[t]he fact that the questions are stored on the computer-readable storage medium does not mean that the 'selecting' step is conducted by the computer." *Id.* The Examiner, however, does not address the first method step of each of claims 1 and 24, which requires "storing personal questions on at least one topic . . . , the personal questions being stored on a computer-readable storage medium . . . ." Appellant respectfully submits that the step of "storing personal questions . . . on a computer-readable storage medium" must be performed by a machine (e.g., a computer).

Appellant further submits that, even if the Examiner's allegation that claims 1 and 24 do not "require a machine for performing claimed method steps" were accurate (a notion that Appellant disputes), claims 1 and 24 still meet the requirement for patent eligibility under 35 U.S.C. § 101 because at least some of the steps recited therein operate on or otherwise involve another class of subject matter, i.e., the computer-readable storage medium. In *In re Comiskey*, Appeal No. 2006-1286, slip op. at 18, (Fed Cir. 2009), the Federal Circuit held that "a claim reciting an algorithm or abstract idea can state statutory subject matter only if, as employed in the process, it is embodied in, operates on, transforms, or otherwise involves another class of statutory subject matter, i.e., a machine, manufacture, or composition of matter." Emphasis added. Appellant respectfully submits that the step of "storing personal questions . . . on a computer-readable storage medium," as recited in independent claims 1 and 24, operates on, or otherwise involves, a machine (e.g., a computer-readable storage medium and a computer), in accordance with *Comiskey*.

Appellant respectfully submits that, for at least the foregoing reasons, independent claims 1 and 24 are directed to patent eligible subject matter under § 101 and that, therefore, the § 101 rejection of claims 1-19 and 24 should be reversed.

**b. The Rejection of Claims 1-24 Under 35 U.S.C. § 103(a) Should be Reversed Because the Nexus Between Received Answers to Personal Questions and Customization of a Test Kit That is Required by Independent Claims 1 and 24 is not Disclosed or Suggested by Maloney, Otworth, or any Combination Thereof.**

The Examiner alleges that "Applicant presents arguments against the references individually." Answer at 13. Appellant respectfully disagrees. As acknowledged in the Examiner's Answer on page 12, Appellant argued in the Appeal Brief that

neither Maloney nor Otworth, nor any combination thereof, discloses or suggests “based on . . . received answers [to a set of personal questions selected from personal questions stored on computer-readable storage medium], selecting from a plurality of testing materials, at least one customized set of testing material,” as recited in claim 1.

Appeal Brief at 18, emphasis added.

It is the Examiner that applies the references individually without providing a legally sufficient reason for modifying Maloney in the hypothetical manner proposed by the Examiner. The Examiner alleges that Maloney suggests a step of selecting at least one set of testing materials, and that Otworth was applied for an alleged disclosure of customizing a set of testing materials. Answer at 12-13. This, however, does address the fact that neither Maloney nor Otworth, nor any other identified source, discloses or suggests the step of selecting a customized set of testing materials based on answers to personal questions, as required by independent claims 1 and 24. The Examiner alleges that

[i]t would have been obvious . . . to modify Maloney to include that said set is selected *based on the received subject's data (including answers)* . . . because it would advantageously allow to accommodate said various profile sub-categories of consumers, thereby providing each customer with said customized test kit (Maloney; page 11, lines 6-10).

Answer at 8, emphasis in original.

Appellant respectfully points out that, although Maloney discloses collecting consumer profiling data, Maloney fails to disclose or suggest customizing a test kit based on the profiling data. More importantly, Maloney does not disclose or otherwise teach customizing a test kit based on answers to personal questions. Therefore, Maloney fails to disclose or suggest “based on . . . received answers [to a set of personal

questions], selecting . . . at least one customized set of testing material," as recited in claims 1 and 24. Emphasis added.

In an apparent recognition of this deficiency of Maloney, the Examiner alleges that it purportedly would have been obvious to modify Maloney to include this feature. The Examiner relies on Otworth, alleging that Otworth purportedly teaches "providing a subject with a customized kit" "based upon collected historical data related to a subject." Answer at 8, emphasis added. Appellant respectfully points out, however, that the "historical data" mentioned in Otworth does not include answers to personal questions, as required by claim 1. Rather, the "historical data" disclosed by Otworth merely includes, for example, "blood sugar levels" (para. [0161]), "high blood pressure" (para. [0168]), etc. Therefore, Otworth does not disclose or suggest "based on . . . received answers [to a set of personal questions]], selecting . . . at least one customized set of testing material," as recited in claim 1, and thus, does not cure the deficiencies of Maloney. Emphasis added.

Appellant also points out that neither Maloney nor Otworth teaches any nexus between received answers to personal questions and the customization of a test kit. Further, Appellant respectfully submits that the Examiner does not point to any other source for this claim feature, nor does the Examiner provide a legally sufficient reason for modifying Maloney to include such a feature. The Examiner alleges that one of ordinary skill in the art would have found it obvious to customize a test kit based on received answers to personal questions "to accommodate said various profile sub-categories of consumers, thereby providing each customer with said customized test kit (Maloney; page 11, lines 6-10)." Answer at 8. Appellant submits that the portion of

Maloney cited by the Examiner (page 11, lines 6-10) does not teach providing a test kit to a consumer based on profiling data. Rather, Maloney discloses that “the collection of profiling data about a consumer comprises providing the consumer [with] a test kit.” Page 11, lines 6-7, emphasis added. Thus, Maloney does not disclose providing a test kit based on the profiling process, but rather as a part of the profiling process.

Even if there were to be a legally sufficient rationale for combining Maloney and Otworth in the hypothetical manner proposed by the Examiner (a notion which Appellant disputes), the hypothetical suggested combination would not meet all of the recited features of independent claims 1 and 24. Because Maloney merely discloses providing a test kit as a part of (and not based on) the profiling process and Otworth merely discloses medical information such as blood pressure or blood sugar level (not answers to personal questions), combining the alleged teachings of Otworth with Maloney would, at best, result in a profiling process that involves medical information, such as blood pressure or blood sugar level. This falls considerably short of the claimed requirement of “based on . . . received answers [to a set of personal questions], selecting . . . at least one customized set of testing material,” as recited in claims 1 and 24.

Appellant respectfully submits that, for at least the foregoing reasons, the Examiner has failed to establish a prima facie case of obviousness with respect to independent claims 1 and 24 and that, accordingly, the § 103(a) rejection of claims 1 and 24 based on Maloney and Otworth should be reversed.

## II. CONCLUSION

In view of the remarks above and the remarks set forth in the Appeal Brief filed February 10, 2009, Appellant respectfully submits that all of the claim rejections should be reversed.

To the extent any extension of time under 37 C.F.R. § 1.136 is required to obtain entry of this Reply Brief, such extension is hereby respectfully requested. If there are any fees due under 37 C.F.R. §§ 1.16 or 1.17 which are not enclosed herewith, including any fees required for an extension of time under 37 C.F.R. § 1.136, please charge such fees to Deposit Account No. 06-0916.

Respectfully submitted,

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Dated: May 18, 2009

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